

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated July 29, 2008 (the “Final Office Action”). Claims 1-7 and 9-13 are presently pending. Applicant cancels Claim 11 without prejudice or disclaimer. Applicant previously canceled Claim 8 without prejudice or disclaimer. Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Objections

The Office Action rejects Claims 11-13 because of certain informalities. Applicant respectfully traverses this rejection.

For purposes of advancing prosecution, Applicant cancels Claim 11 without prejudice or disclaimer. Applicant respectfully notes that, with respect to all cancellations and amendments herein, Applicant reserves the right to pursue broader subject matter than that presently claimed through the filing of continuations and/or other related applications.

With respect to Claim 12, the Final Office Action alleges that “[i]t’s not clear how the limitations of claim 12 further limits step (a) of ‘receiving information’ In particular, the Final Office Action indicates that it is allegedly unclear how “‘additional’ data or information [would] further limit the ‘plural information’ in steps (a)-(c) of claim 1 above.” Final Office Action, p. 3. At the outset, Applicant respectfully disputes the Final Office Action’s characterization of the present claims to the extent that the Final Office Action suggests that Claim 1 requires plural “information” or plural “data.”

Additionally, Applicant respectfully notes that the preamble of Claim 12 recites “[t]he method of Claim 1, further comprising:” Therefore, Claim 12 includes every limitation of Claim 1 from which Claim 12 depends. In addition, Claim 12 recites additional elements, such as “determining whether to request additional information about the business event based at least in part on the business data included in the business event message” and “requesting the additional information from an information provider” that are not present in Claim 1. These additional elements further limit the claim from which they depend by adding additional method steps to those recited by Claim 1. Thus, while the Final Office Action incorrectly suggests that Claim 12 adds nothing to Claim 1 beyond “additional data or information,” Claim 12 includes multiple additional method steps not recited by Claim 1.

Furthermore, in regards to dependent claims, the M.P.E.P. states that:

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

M.P.E.P. § 608.01(n).

As § 608.01(n) emphasizes, the “significance of the further limitation added by the dependent claim” and “whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends” is not the appropriate inquiry to determine whether the claim is in proper dependent form. *Id.* The proper test is simply “whether the dependent claim includes every limitation of the claim from which it depends.” *Id.* Here, Claim 12 explicitly includes every limitation of Claim 1, and the Final Office Action fails to identify any reason why the wording of Claim 12 would result in any element of Claim 1 not being included in Claim 12. Thus, while Claim 12 clearly provides additional limitations beyond those of Claim 1, the M.P.E.P. explicitly notes that Claim 12 is not required to further limit Claim 1 as the Final Office Action suggests. As a result, the Final Office Action fails to identify any proper basis for objecting to Claim 12 as an improper dependent claim. Applicant respectfully requests withdrawal of the objection to Claim 12.

With respect to Claim 13, the Final Office Action alleges only that “[i]t’s not clear how the limitations of claim 13 further limits ‘the business event message’ of step (c) above[.]” Final Office Action, p. 3. The Final Office Action fails to explain the basis for any confusion regarding the scope of Claim 13, and thus this objection is improper. Additionally, Applicants respectfully note that Claim 13 recites, in part, an additional method step of “displaying a message for the successor event when the expected time period has been reached and the successor event has not occurred” that is not included in Claim 1. Furthermore, as noted above, the M.P.E.P. requires only that “the dependent claim includes every limitation of the claim from which it depends.” M.P.E.P. § 608.01(n). Claim 13 clearly satisfies this requirement. As a result, the Final Office Action fails to identify any basis for objecting to Claim 13 as an improper dependent claim. Applicant respectfully requests withdrawal of the objection to Claim 13.

Section 103 Rejections

Claims 1-7 and 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Internet documents entitled “Oracle Delivers Global Sales and Marketing Analysis to the Web” (“*Oracle*”) or “PeopleSoft Announces Balanced Scorecard for Strategic Decision-Making” (“*PeopleSoft*”) or “Cognos (R) Introduces Unparalleled Foundation for End-to-End Business Intelligence” (“*Cognos*”). Applicant respectfully traverses this rejection.

In response to arguments Applicant presented in a Response to Office Action filed April 8, 2008 (the “April 8 Response”), the Office Action alleges that the “business event message” and “business data” recited by Claim 1 are “considered as functional descriptive material (FDM) and have no patentable weight.” Final Office Action, p. 9. Applicant respectfully disputes this characterization and conclusion.

First, Applicant respectfully notes that the Office Action provides no statutory or case law basis for treating the relevant claim elements as “functional descriptive material.” Applicant requests that, if the Examiner intends to maintain this rejection, the Examiner cite to some authority supporting the Examiner’s conclusion that the recited “business event message” and “business data” should be considered functional descriptive material.

Furthermore, even assuming that the Final Office Action correctly treated the claim elements in question as functional descriptive material, the Final Office Action also provides

no statutory or case law basis for the assertion that functional descriptive material “does not have much patentable weight.” Final Office Action, p. 9. Applicant respectfully reminds the Examiner that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Applicant requests that, if the Examiner intends to maintain this rejection, the Examiner cite to some authority supporting the Examiner’s conclusion that functional descriptive material “have no patentable weight.” Final Office Action, p. 9. Thus, the rejection of Claims 1-7 and 9-13 is improper for at least these reasons.

In addition, the Final Office Action also reiterates the Examiner’s original basis for rejecting Claims 1-7 and 9-10 by asserting that “[t]he steps of (a)-(e) are merely steps involved in monitoring and reporting a business performance” and that “these steps are inherently including [sic] in the accessing the information, monitoring and analyzing and marketing of data including the tracking of the KPO via a standard web browser as cited in ORACLE above.” Final Office Action, p. 5. In response, Applicants again note that the Final Office Action improperly paraphrases Claim 1 by stating simply “[t]he steps of (a)-(e) are merely steps involved in monitoring and reporting a business performance.” See Final Office Action, p. 5. Applicant respectfully notes that rejecting a claim based on a paraphrasing or summary of the claim’s language is improper. As noted above, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Thus, Applicant respectfully requests that, if the Examiner intends to maintain this rejection of Claim 1, the Examiner address each element of Claim 1 directly, as required by M.P.E.P. § 2143.03.

Additionally, with respect to the Final Office Action’s assertion that “these are inherently including [sic] in . . . the tracking of the KPI via a standard Web browser as cited in ORACLE above,” Applicant respectfully reminds the Examiner that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” M.P.E.P. § 2112 (emphasis added). Inherency, however, may not be established by probabilities or possibilities. *Id.* “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* (emphasis added); *see also*

In re Robertson, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q. 1461, 1464 (Bd. Pat. App. & Inter. 1990). Not only does the Office Action improperly paraphrase the language of Claim 1, but the Office Action provides no basis to reasonably support the determination that the paraphrased elements of Claim 1 are necessarily present in the teachings of *Oracle*. Consequently, a rejection based on inherency is clearly improper here.

As a result, the proposed *Battat-Cognos-PeopleSoft-Oracle* combination fails to disclose, teach, or suggest every element of Claim 1 as Applicant previously noted. See, e.g., April 8 Response, pp. 7-10. Furthermore, the newly-presented arguments in the Final Office Action fail to address the deficiencies Applicant previously noted. Claim 1 is allowable for at least these reasons. Although of differing scope from Claim 1, Claims 9 and 10 are allowable for at least analogous reasons. Applicant respectfully requests reconsideration and allowance of Claims 1, 9, and 10, and their respective dependents.

Conclusions

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or to credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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